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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/802,906

03/17/2004

Gary K. Michelson

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EXAMINER

LAWSON, MATTHEW JAMES

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

12/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/802,906	Applicant(s) MICHELSON, GARY K.	
	Examiner MATTHEW LAWSON	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-42 and 44-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-42 and 44-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/1/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

Claims 7-42, and 44-51 are allowable contingent upon a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Double Patenting

The following patents and patent applications have been considered for double patenting in the examination of this application:

Patents:

- 6,936,050 - 6,926,718 - 6,454,771 - 7,044,952 - 6,527,776 - 6,193,721
- 6,936,051 - 6,398,783 - 7,041,105 - 7,077,844 - 7,118,573 - 6,383,186
- 6,416,528 - 6,428,542 - 6,592,586 - 6,616,666 - 6,620,163 - 6,712,818
- 6,916,320 - 6,969,390 - 7,074,221 - 7,097,645 - 7,112,202 - 7,115,130
-6,139,550

Applications:

- 10/926,734 - 11/110,161 - 11/128,556

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 7-42 and 44-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over:

claims 1-173 of U.S. Patent No. **6,193,721**

claims 1-39 of U.S. Patent No. **6,936,051**

claims 1-117 of U.S. Patent No. **6,398,783**

in view of Reisberg (US Patent 5,468,242).

Comparison of Current Application against Conflicting Patents:

'721 Patent: **Concave** (in dependent claims, e.g. 7, 10), **Silent** in independent claims (1, 28) instead of **convex/flat**; locking element for covering first and second bone screw receiving holes.

'051 Patent: **Concave** instead of **convex/flat**; lock for at least two bone screw receiving holes.

'783 Patent: **Concave** instead of **convex/flat**; lock for at least two bone screws (inserted in two bone screw receiving holes).

Reisberg teaches (**Column 1, Lines 5-20**) that having implants that conform to the bone surface/anatomical shape (e.g. convex, flat, and concave) is desired. One having ordinary skill in the art at the time the invention was made would have developed a device that either was pre-shaped or moldable to conform to the anatomy to provide for a low profile fit that would 1) minimize external visualization of implant and therefore embarrassment of patient 2) irritation from inflammation 3) allow fixation members (screws, tacks, pins, etc) to have greater holding force (instead of having a significant portion hanging out of the bone). Therefore, applicant's numerous patents attempting to

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differentiate bone plates on the premise of concave vs. convex/flat are not novel. The mere shaping of an interface surface to conform to the intended bone to which it is to be placed is already known to be desired and beneficial.

Any additional difference between the previous patents and the current application lies in the fact that the claims (taking into account dependent claims in several) in the patents include more elements and are thus more specific. The inventions therefore define a "species" of the "generic" invention of claim 7. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claims 7-42 and 44-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over

claims 1-72 of copending Application No. **10/926,734**

claims 1-62 of copending Application No. **11/128,556**

in view of Reisberg. As discussed in the patent section, applicant is merely reciting a concave base section with one application being "at least one" again with the other being "at least two" in regard to the bone receiving holes. Each one recites at least "two bone screws" in regard to a locking element

This is a provisional obviousness-type double patenting rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW LAWSON whose telephone number is (571)270-7375. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. L./
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775